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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,035	07/19/2001	Paul Steger		8475

7590 12/21/2004
HOWISON, THOMA & ARNOTT, L.L.P
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DALLAS, TX 75374-1715

EXAMINER

FRECH, KARL D

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/909,035		STEGER, PAUL	
	Examiner		Art Unit	
	Karl D Frech		2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Applicant's Request for Continued Examination filed November 4, 2004 has been received.
2. Applicant has amended further broaden claim 1 by removing the "means for automatically determining..." element.
3. Claims 1-11 remain rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Applicant, through the amendment of December 8, 2003 proposes to amend the claims to change the language of the claims to replace "underwriting institution switch" with "remote terminal computer". Applicant argues that "underwriting institution" and "remote terminal computer" are essentially the same. Applicant argues that "underwriting institution" has no relevance and is really an adjective. The examiner

agrees that “underwriting institution” is an adjective, disagrees that it has no relevance. “Underwriting institution switch” was added to overcome rejection in the parent application and thus definitive of the claimed invention. The examiner further respectfully disagrees that “underwriting institution” and – remote terminal computer— are essentially the same. An underwriting institution is a financial entity and is thus defining of the claimed invention. A “remote terminal computer” removes the financial aspect (examiner’s words) of the Patented claim. As this term was added to overcome the rejection of the parent application, and is considered to be descriptive of the current claim, removal of this terminology from the claim would broaden the scope of the claims passed what was surrendered in the parent application resulting in recapture.

4. Applicant's arguments filed November 4, 2004 have been fully considered but they are not persuasive. Applicant continues to argue that the replacement of “underwriting institutional switch” with the term - - remote terminal computer - - should not be considered as recapture. The examiner still respectfully disagrees. If, for argument’s sake only, applicant’s statement that the two terms are merely alternate wording of the same element with the same scope, applicant should have no objection to returning to the original wording of the element. However, applicant’s insistence that the term - - remote terminal computer - - be used is indication that there is an issue regarding the interpretation of the element. However, as seen in the previous non Final rejection of June 4, 2003, the previous Final rejection of May 4, 2004 and repeated above, the examiner maintains that the change in terminology does, in fact, alter the scope of the claims and does clearly suggest recapture. As seen in the non-Final

rejection of June 4, 2003 during the prosecution of the parent 08/523,646 application, the term "bidirectional underwriting institution switch" was specifically added to overcome the rejection based on Write. This, along with the fact that in their normal definitions, "underwriting institution" and - - remote terminal computer - - are not identical, clearly suggests recapture. As seen above, as in the Final rejection of May 4, 2004, a - - remote terminal computer - - removes the financial aspect (examiner's words) of the Patented claims. Whether or not applicant agrees that the - - remote terminal computer - - actually is different from the "bidirectional underwriting institution switch" does not negate the fact that the "bidirectional underwriting institution switch" was specifically added to the now Patented claims (from 08/523,646) to overcome a rejection based upon the reference to Write. Thus the examiner maintains that the current claims improperly attempt to "recapture".

5. This is an RCE of applicant's earlier Application No. 09/909,035. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

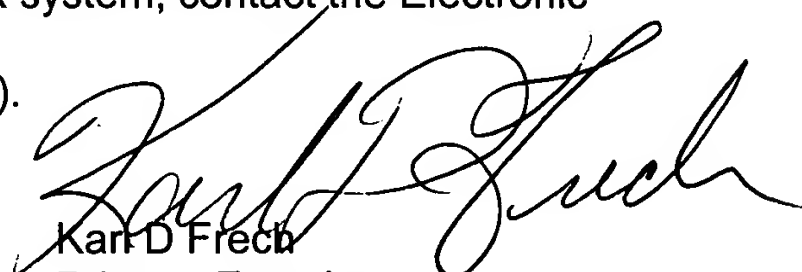
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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl D Frech whose telephone number is (571) 272-2390. The examiner can normally be reached on maxi-flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Karl D Frech
Primary Examiner
Art Unit 2876
